UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,205	07/24/2003	Puthukode G. Ramachandran	AUS920030501US1	9668

35525   7590   05/23/2008
IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380

EXAMINER
DAO, THUY CHAN

ART UNIT	PAPER NUMBER
2192	

NOTIFICATION DATE	DELIVERY MODE
05/23/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _03_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _20 February 2008_.

2a)☒ This action is FINAL.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-5 and 7_ is/are pending in the application.

    4a) Of the above claim(s) _6 and 8-19_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-5 and 7_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _24 July 2003_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _01/15/08_.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on February 20, 2008.

2. Claims 1-5 and 7 have been examined.

Response to Amendments

3. In the instant amendments, claims 1-5 and 7 were amended; claims 6 and 8-19 were canceled.

Information Disclosure Statement

4. The Office acknowledges receipt of the Information Disclosure Statement filed on January 15, 2008. It has been placed in the application file and the information referred to therein has been considered by the examiner.

Drawings

5. The drawings are objected to because of minor informalities.

   Figure 7: in light of specification, page 21, lines 12-16, both block 732/YES and block 706/NO would proceed directly to block 728 (not below block 728).

   Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The specification is objected to because of minor informalities.

Acronyms should be spelled out at the first appearance in the specification (e.g.,
page 10, "PDA" and page 12, "BD2"); and

Page 21, line 7, 726 should be 728;   line 8, 728 should be 730, and line 12, 730
should be 732.

Appropriate correction is required.

Response to Arguments

7. In the instant amendments, the Applicants added new limitations (claim 1, lines 8-14):

"responsive to a determination that the new software module is not known to
function compatibly with the existing set of software modules, referring to the knowledge base
of software modules to determine whether the new software module is known to function
incompatibly with the existing set of software modules; and

responsive to a determination that the new software module is not known to
function incompatibly with the existing set of software modules, testing the new software
module in a test data processing system in combination with the existing set of software
modules",

and asserted that,

"In contradistinction, claim 1 recites a two-pronged test to
determine whether to test the component … Thus, as recited in
claim 1, a knowledge base is checked to see if there is information
present that indicates that the new component and the prior
installed components function compatibly. If there is not
information indicating that the new component and the prior
installed components function compatibly, the knowledge base is
checked to see if there is information present that indicates that the
new component and the prior installed components function
incompatibly. If there is not information indicating that the new

component and the prior installed components function
incompatibly, then the new software is tested in a test data
processing system" (Remarks, page 8, second paragraph,
emphasis added).

However, after further consideration, the examiner notes that there is no two-
pronged test as asserted by the Applicants. As clearly set forth in the specification,
page 18:

"In addition, a negative result is considered to be present in
these examples if data regarding the compatibility of the
combination of software modules is absent" (lines 15-18); and

"If a negative result is returned, a determination is made
whether to test the combination (step 708)" (lines 23-24).

That is to say, the originally filed disclosure explicitly sets forth "a determination
that the new software module is not known to function compatibly with the existing set of
software modules" (claim 1, lines 8-9) as "a negative result" (specification, page 18, lines
11-22 and FIG. 7, block 706/YES), then the process would proceed to "test the
combination" (specification, page 18, lines 23-29 and FIG. 7, block 708), but does not
support the "two-pronged test" as asserted in the Remarks, page 8.

In light of the originally filed disclosure (page 18, lines 11-24), the examiner treats
the newly added limitations in claim 1 as:

lines 8-9, "responsive to a determination that the new software module is not
known to function compatibly with the existing set of software modules" (either determining "a
negative result" as data regarding the compatibility is absent as set forth in the
specification, page 18, lines 15-18);

lines 9-11, "referring to the knowledge base of software modules to determine
whether the new software module is known to function incompatibly with the existing set of

software modules" (or determining "a negative result" as some selected percentage of combinations is incompatible as set forth in the specification, page 18, lines 18-20).

then responsive to either type of "negative result", the method proceeds to "testing the new software module ..." as recited in claim 1, lines 13-14.

8. Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections – 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,948,059 to Sprecher et al. (art made of record, hereafter "Sprecher") in view of "Tool to Facilitate Testing of Software to Insure Compatibility", IBM Technical Disclosure Bulletin, April 1988 (art made of record, hereafter "IBM-Bulletin").
Claim 1:

Sprecher discloses *a method for testing the compatibility of software modules, the method comprising the computer implemented steps of:*

responsive to receiving a request to install a new software module in a data processing system (e.g., col.2: 3-12; col.5: 36-45),

performing an inventory on an existing set of software modules resident in the data processing system (e.g., FIG. 5, block 52 "Review Available Component Table", col.7: 5-19; and details of said table in FIG. 4, col.6: 20-54);

referring to a knowledge base of software modules to determine whether the new software module is known to function compatibly with the existing set of software modules (e.g., FIG. 5, block 50 "Read next Required Component", col.7: 5-19; and details of Required Component List in col.5: 52-67)*;*

responsive to a determination that the new software module is not known to function compatibly with the existing set of software modules (e.g., FIG. 5, block 66 "Hit? NO", col.7: 20-41),

referring to the knowledge base of software modules to determine whether the new software module is known to function incompatibly with the existing set of software modules (e.g., FIG. 5, block 72, col.7: 42-59)*; and*

responsive to a determination that the new software module is not known to function incompatibly with the existing set of software modules (e.g., FIG. 5, block 84 → NO, col.7: 60 – col.8: 8),

loading the new software module in a data processing system in combination with the existing set of software modules (e.g., FIG. 5, block 84 "Compatible?" NO → 86 → 92, col.8: 1-44).

Sprecher does not explicitly disclose *testing the new software module in a test data processing system in combination with the existing set of software modules.*

However, in an analogous art, IBM-Bulletin further discloses *testing the new software module in a test data processing system in combination with the existing set of software modules* (e.g., page 3, lines 28-46, perform a "sniff test" of the new software "to insure the new software is, indeed, compatible").

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine IBM-Bulletin's teaching into Sprecher's teaching. One would have been motivated to do so to insure the new software is indeed compatible with the existing software applications as suggested by IBM-Bulletin (e.g., page 3, lines 18-40).

Claim 2:

The rejection of claim 1 is incorporated. Sprecher also discloses *wherein testing the new software module in a test data processing system in combination with the existing set of software modules comprises:*

prompting a user for a first selected input; responsive to a first selected user input (e.g., col.6: 20-39),

testing the new software module in a test data processing system in combination with the existing set of software modules (e.g., col.6: 34-54)*; and*

responsive to a second selected user input, installing the new software module in the data processing system (e.g., col.6: 50-67).

Claim 3:

The rejection of claim 1 is incorporated. Sprecher also discloses:

responsive to a determination that the new software module is known to function incompatibly with the existing set of software modules, prompting a user for a first input (e.g., col.8: 9-27)*;*

responsive to a first selected user input, testing the new software module in a test data processing system in combination with the existing set of software modules (e.g., col.8: 45-60)*; and*

responsive to a second selected user input, installing the new software module in the data processing system (e.g., col.8: 28-64).

Claim 4:

The rejection of claim 1 is incorporated. Sprecher also discloses:

responsive to a test result indicating that the new software module is compatible with the existing software modules (e.g., col.5: 10-34),

adding a new combination indicating the compatibility to the knowledge base; and installing the new software module in the data processing system (e.g., col.5: 46-67).

Claim 5:

The rejection of claim 1 is incorporated. Sprecher also discloses:

responsive to a determination that the new software module is not compatible with the existing software modules (e.g., col.6: 1-19),

adding a new combination indicating the incompatibility to the knowledge base and searching the knowledge base to find a closest match, wherein at least one of the existing modules is removed or replaced with a different version (e.g., col.5: 46-67);

prompting for the user as to availability of the closest match combination; and responsive to a user input, installing the new software module and changing the existing modules as needed to obtain a compatible combination (e.g., col.6: 20-43).

Claim 7:

The rejection of claim 1 is incorporated. Sprecher also discloses *testing the new software module in a test data processing system in combination with the existing set of software modules comprises:*

identifying an environment of a client in which the software module is to be installed (e.g., col.6: 55-67);

recreating the environment on a test data processing system (e.g., col.7: 6-31); *and*

installing the software module on the test data processing system to form the installed software module (e.g., col.7: 42-59).

Conclusion

11. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/
Examiner, Art Unit 2192

/Tuan Q. Dam/
Supervisory Patent Examiner, Art Unit 2192